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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,410

01/05/2005

Yosuke Egawa

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EXAMINER

TOSCANO, ALICIA

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

01/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/519,410

Applicant(s)

EGAWA, YOSUKE

Examiner

Alicia M. Toscano

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,7-11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 7-11 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Priority***

1. As set forth in the last action, a certified translation of the foreign priority received. Effective filing date is 7/8/02.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-2, 4, 7-8, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terada (US 6326440) in view of Obuchi (JP 2001-049098).

This rejection is as set forth in the action dated 9/12/07. Rejection over claims 3, 5-6, 12-13 and 15 are withdrawn since said claims are now cancelled.

Regarding the new limitation "degree of crystallization of 20% or less", this is as set forth previously for the degree of crystallization of 45% or less, wherein, since Terada and Obuchi meet the compositional and thickness requirements of the biodegradable sheet it is the Examiner's position that the degree of crystallization is inherent.

Regarding the new limitations "wherein the molded article is a deep-drawn molded article having a draw ratio of 0.5 or more", said limitation is viewed as a product by process claim. The molded article has a thickness of 100-500 microns, which is met, thusly, the process by which the product is produced is not pertinent unless the Applicant can show otherwise. The limitation is rejected as such.

Remarks:

Applicant argues the degree of crystallization of 20% or less is shown in the Applicant's Examples to result in better moldability and said result is unexpected over Obuchi. Applicant further argues that since excellent results are found when the draw ratio is 0.5 or greater and the degree of crystallization is 20% or less, unexpected results are shown over Terada and Obuchi.

Examiner disagrees. The Examiner was in no way using Obuchi to teach the crystallization of the final product. It was the Examiner's position that since Terada (who teaches the composition) and Obuchi (who is used solely to teach the thickness of the end product) meet the compositional and thickness requirements of the end product that the degree of crystallization must be inherent. Examiner requests evidence to the contrary. Since Obuchi is not used to teach the composition it is improper to say that Terada would have the degree of crystallization of Obuchi's Examples. Applicant has not shown that Terada would not inherently encompass the claimed degree of crystallization. Reference to unexpected results is moot since it is the position of the Examiner that Terada would inherently encompass the degree of crystallization of the claims, and would thusly also encompass the superior properties.

Further regarding the draw ratio, since this is a product by process claim, Applicant must show that there is a difference in the product produced by Terada/Obuchi versus using the draw ratio of Applicant's claims. That Applicant shows superior properties when the draw ratio and degree of crystallization are within a certain range is moot, since it is the Examiner's position that the degree of crystallization would

Art Unit: 1796

be inherent in the sheet of Terada and Obuchi, and further that the properties found by making a sheet said thickness would also be found in the product of Terada and Obuchi.

The rejections stand as such.

3. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terada and Obuchi in further view of Obuchi (US 2002/0002252).

This rejection is as set forth in the action dated 9/12/07.

Remarks:

Applicant argues Obuchi '252 does not make up for the deficiencies of Terada and Obuchi '098.

Examiner disagrees. Terada and Obuchi '098 are not deficient for the reasons set forth above. The rejection stands as such.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1796

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

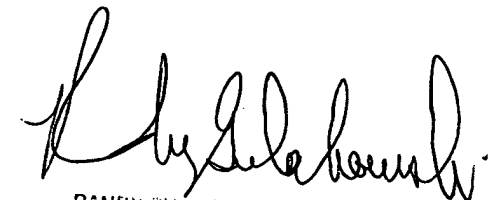
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Toscano whose telephone number is 571-272-2451. The examiner can normally be reached on Monday to Friday 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMT



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